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Remarks

Currently Claims 1-6, 9-17 and 19-20 are pending. Claim 20 is amended.

Section 112. Second Paragraph Rejections Overcome

Claim 14 currently stands finally rejected under 35 U.S.C. §112, second paragraph, the Office Action stating that a composition claim should have more than one ingredient. Applicants respectfully maintain the traversal of this rejection.

It is respectfully submitted that the stated reasons for rejection do not address the proper standard for definiteness under 35 U.S.C. §112. The claim at issue must be examined as a whole, with every limitation considered. MPEP2106. Definiteness is to be evaluated in light of, among other things, the claim interpretation that would be given by one of ordinary skill in the art at the time the invention was made. MPEP 2173.02. The claim terms must be given the broadest reasonable interpretation consistent with the interpretation one skilled in the art would reach. MPEP 2111; *In re Cortright*, 49 USPQ2d 1464 (Fed. Cir. 1999). Definiteness under section 112 is satisfied if the claim is sufficient to allow one skilled in the art to understand what will constitute infringement of the claim. MPEP 2173.

Claim 14 recites "A pharmaceutical composition comprising..." The Examiner's analysis firstly appears to improperly ignore the term "pharmaceutical composition," and secondly fails to give the claim a reasonable interpretation in light of the manner in which one skilled in the art would interpret the claim. One of ordinary skill in the art would understand the term "pharmaceutical composition" to mean a composition suitable as a pharmaceutical. There can be no doubt that one skilled in the art understands the metes and bounds of the term "pharmaceutical composition" in view of its prolific use in granted patents. The Examiner is invited to conduct an electronic search of granted US patents for the claim language "pharmaceutical composition" for incontrovertible evidence that this is indeed a well-recognized term of art.

There is no legal authority for the Examiner's argument that a claim directed toward a pharmaceutical composition must recite more than one component. The Examiner is correct in stating that the term "comprising" is open-ended, and Applicants' acknowledge the case law cited by the Examiner on this point. This case law, however, fails to support the Examiner's incorrect assertion that a claim directed

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toward a pharmaceutical composition must recite more than one component. On this specific point, there is no legal authority to support the rejection.

The case law cited the Examiner further establishes that despite being an open-ended term, the term "comprising" does not render the claim indefinite because it does not preclude one of ordinary skill in the art from determining what is and is not within the scope of the claims. The Examiner appears to be arguing that the term "comprising" renders the claim indefinite by implying that some un-named components are excluded. As the cited cases make clear, the term comprising does not exclude components. One of ordinary skill in the art would not interpret a first claim reading "comprising A and B" and a second claim reading "further comprising C" as implying that "comprising" in the first claim must mean C is excluded. Use of the term "comprising" is not unclear, nor does it introduce indefiniteness. Accordingly, the rejection of claim 14 under section 112 is improper for these reasons and withdrawal is respectfully requested.

Claim 19 currently stands rejected under 35 U.S.C. §112, second paragraph, the Office Action stating that the claim is duplicate of claim 17. Applicants respectfully traverse this rejection.

The Examiner is correct in that the words of the two claims differ. The claims are required to be examined in light of the limitations recited in that claim. Claim 17 recites "a method for the treatment of a herpes viral infection..." Claim 19 recites "a method for the treatment of a condition or disease associated with a herpes viral infection." Should the Examiner require further explanation of the difference between these claims, it is respectfully requested that the Examiner consult page 22 of Applicants' specification.

Claim 20 currently stands rejected under 35 U.S.C. §112, second paragraph, the Office Action indicating that the claim is indefinite for reciting a process for preparing a subset of compounds of claim 1. While Applicants do not agree with the basis for rejection, the preamble of claim 20 has been amended to clarify the compounds of claim 1 which are prepared by the claimed process. The amendment does not narrow the scope of the claim. Inasmuch as the amendment overcomes the rejection of claim 20, entry of the amendment is proper under 37 CFR 1.116 and is requested.

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Applicants respectfully submit that the instant application is in condition for allowance, which action is respectfully requested. The Examiner is invited to contact the undersigned at (919) 483-8222, to discuss this case, if desired.

Respectfully submitted,



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